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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,223	11/18/2003	Takahiro Nakajima	11197/5	3150
23838 7590 04/29/2008 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER MCDONOUGH, JAMES E				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
04/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/830,223

## Applicant(s)

NAKAJIMA ET AL.

## Examiner

JAMES E. MCDONOUGH

## Art Unit

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 78-92,94-118 and 125-166 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 82-92,96-106,108-113,115-118,131-141 and 143-166 is/are allowed.
- 6) ☒ Claim(s) 78-81,94,95,107,114,125-130 and 142 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/14/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Original Rejections

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 78-81, 94, 95, 107, 114, 125-130, 142, and 162-166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu, U.S. Statutory Invention Registration H766 (hereafter referred to as Yu).

Yu discloses the invention substantially as claimed (col. 2, 1. 34 to col. 3, 1. 35; col. 3, 1. 67 to col. 4, 1. 20; col. 4, 1. 45-60; col. 5, 1. 21 to col. 6, 1. 8, col. 7, 1. 7-62). Especially note the catalyst used in col. 5, 1. 26 to col. 6, 1. 2, which discloses that a

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mixture of a metal compound and a phenol may be used as the catalyst, the phenol corresponding to present formula 1 of claim 125.

Yu lacks the specifics of the presently claimed process performed with its disclosed catalyst, especially the particular starting materials which may be polymerized with its catalyst.

However, Yu teaches that these starting materials may be polymerized with another disclosed catalyst similar to that of the present claims.

It would have been obvious to one of ordinary skill in the art to apply that skill to the disclosure of Yu with a reasonable expectation of obtaining a highly-useful process for making a polyester with the expected benefit of the process not requiring metals conventionally used in polyester production.

### ***Claim Objections***

Claims 82-92, 96-106, 108-113, 115-118, 131-141, and 143-166 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Response to Arguments**

Applicants argue that the amendment to their claim requiring the metal containing component and the organic component to be added separately overcomes the rejection. This is not persuasive because as even admitted by applicants the phenol is first melted

then used to dissolve the metal compound, this method inherently is adding the two components separately. Further applicants have not shown that phenol or the metal compounds are by themselves catalytic.

Applicants then argue that Yu is not adding the two components separately to the reaction chamber. This is not persuasive because this limitation is not claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., adding the components separately to the reaction mixture, the claims only limit that the two components are added separately, but does not this is to the reaction mixture.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants argue that the reference do not teach the two components lack catalytic activity by themselves, however, the reference is using compounds reading on the instant claims, and applicants have not shown that these components are catalytically active by themselves or how one skilled in the art would determine this, further applicants are reminded that there are no test facilities at the USPTO.

Applicants argue that their addition has several advantages. These arguments are not persuasive for at least the following reasons:

- 1.) Applicants argue that their invention is not limited to components that are soluble in the organic compound, applicants are reminded that solubility is a relative function and there is no disclosure in the reference as to limits on the metal compound due to

solubility of the metal compound in the organic compound, applicants appear to be reading non-existent limitations into the reference.

2.) Applicants argue that their invention allows for controlling the amount/ratio of the two components, applicants are reminded that the ratio of the compounds of the reference can also be adjusted.

3.) Applicants argue that by adding the components separately the ratios can be changed during a continuous process, applicants are reminded that the ratios of the two components can also be adjust over time in the reference.

4.) Applicants argue that in their invention that the catalyst may be added before the polymerization, applicants are reminded that the reference teaches that the catalysis take place at higher temperature, so if the catalyst is added at room temperature, it can be added before the polymerization begins.

5.) All these alleged advantages can be performed with the reference invention contrary to applicant's assertion that it can not.

Applicants argue that the reference does not teach the use of an Ar-N moiety. This is not persuasive and the applicants are respectfully requested to reread the rejection and the references where it will be seen that the reference does indeed teach the use of Ar-N moiety.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES E. MCDONOUGH whose telephone number is (571)272-6398. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/  
Supervisory Patent Examiner, Art Unit 1793

JEM 4/23/2008

**Application Number**

Application/Control No.

09/830,223

Examiner

JAMES E. MCDONOUGH

Applicant(s)/Patent under  
Reexamination

NAKAJIMA ET AL.

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